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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,067	05/21/2001	Ulf Neidlein	50555	9147

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1101 Connecticut Avenue NW
Washington, DC 20036

EXAMINER

QAZI, SABIHA NAIM

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,067

Applicant(s)

NEIDLEIN ET AL.

Examiner

Sabiha Naim Qazi

Art Unit

1616

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-6,8-10,12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-6,10,12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 8 and 9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Claims 1-6, 8-10, 12 and 14 are pending in this application. Applicants' in their response indicate claims 1-6, 10, 12 and 14 are pending, which is probably a typing error. This application has been filed under 35 USC 371 as a national stage application of PCT/EP99/09413.

In response to restriction requirement in paper no. 5 mailed March 4, 2002, applicant has elected the invention of group I, claims 1-6, 10 and 12 and a species of No. 2.2 in Table 2, page 39.

The inventions of claims 8 and 9 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: There is no significant common structural element on which the utility is described. They are different from each other and one reference applied to reject the invention of one group cannot be used for any other group for the same reason. They are patentably distinct.

Compounds of claims 8 and 9 are not related to the compounds of formula I, where branched alkyl group at N-1 is present. Since intermediates of formula (III) and (IV) of claims 8 and 9 do not contribute the distinguishing feature, i.e. the alkyl group at N-1, therefore, does not comply PCT rules. Claims 8 and 9 are withdrawn from consideration as non elected invention.

Claim 7 has been canceled. All non-elected invention has not been canceled (i.e. claims 8 and 9).

Applicant's claims are drawn to a 3-(heterocyclyl)-substituted benzopyrazole of formula I, their process of preparing, process for making the composition and method for controlling undesirable vegetation.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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Claim 11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 is improperly dependent on claim 8, as claim 8 is not drawn to composition. Correction is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patent ability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-6, 10, 12 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over von Deyn et al. (US 5,846,907). See the entire document especially lines 17-50, col. 2 and formula 1c where R1

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represents C1-C4 -alkyl group; lines 1-67, col. 4; lines 1-57, col. 5; diagram 4 in cols. 7 and 8; diagram 5 col. 7-10; Table 1 lines 1-67, col. 20; lines 1-33, col. 21 and tables 2-5.

Instantly claimed compounds differ from the reference in having a branched alkyl group attached to N-1 of the pyrazole ring whereas prior art teaches C1-C4 alkyl group at the same position.

It would have been *prima-facie* obvious to one of the skill in the art at the time of invention was made to have made structurally similar compounds having an alkyl group branched or straight chain at N-1 position and their composition for the same use because prior art teaches alkyl group.

2. Claims 1-6, 10, 12 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over von Deyn et al. (WO 98/31681). See the entire document especially line abstract of the invention, formula I on page 1; formula II on page 3 where R16 can be C1-C6 alkyl.

Instantly claimed compounds differ from the reference in having a branched alkyl group attached to N-1 of the pyrazole ring whereas prior art teaches C1-C4 alkyl group at the same position.

It would have been *prima-facie* obvious to one of the skill in the art at the time of invention was made to have made structurally similar compounds having an alkyl group branched or straight chain at N-1 position composition for the same use because prior art teaches alkyl group.


Process of making are taught by the prior art and would have been obvious to one skill in the art.

No unobvious or unexpected results are noted; no claim is allowed.

Elected species is allowable as prior of record does not teach or suggest this compound.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Naim Qazi whose telephone number is 703-305-3910. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

October 23, 2002


SABIHA QAZI, PH.D
PRIMARY EXAMINER